

### **REMARKS**

The present submission is submitted in response to the Office Action mailed February 17, 2005. Claims 1-4, 43-46 and 90-103 are pending in the present application, with claims 1, 43, 90 and 98 being the independent claims.

In the Office Action, the Examiner rejected claims 1-4 and 43-46 and 90 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,327,578 issued to Linehan ("Linehan") in view of U.S. Pat. No. 5,590,197 issued to Chen et al. ("Chen"). In addition, claims 91-97 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Linehan and Chen and further in view of U.S. Publication No. 2004/0031856 to Atsmon et al. ("Atsmon"). Moreover, claims 98-103 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Linehan and Chen in view of Atsmon. The Examiner's rejections are respectfully traversed and reconsideration of the amended claims is hereby requested.

With respect to the rejections of the claims under 35 U.S.C. §103(a) as being unpatentable in view of Linehan and Chen (independent claims 1, 43 and 90) and Linehan, Chen and Atsmon (independent claim 98), Applicants respectfully submit that the claims distinctly define the present invention from any of the references of record, taken singly or in combination, for the reasons that follow.

In the Office Action, the Examiner acknowledged that Linehan does not expressly disclose various steps contained in Applicants' claims but asserted that Chen (independent claims 1, 43, and 90) and Atsmon (independent claim 98) disclose those missing steps. More specifically, with respect to independent claims 1, 43 and 90, the Examiner stated:

Linehan does not expressly disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion

of said assembled credentials to said user, receiving a second request from said user at said server, said second request including said portion of said assembled credentials provided to said user and validating at said server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service.

Office Action, dated February 17, 2005, p. 3, para. 5. The Examiner further asserted that Chen supplies the missing elements, and stated:

Chen et al. [at column 6, lines 12-57] disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least one portion of said assembled credentials to said user, receiving a second request from said user at said server, said second request including said portion of said assembled credentials provided to said user and validating at said server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service.

Office Action, dated February 17, 2005, p. 3, para. 5.

Applicants respectfully disagree that Chen discloses or supplies the missing elements. Specifically, Chen discloses a “cyber wallet” for the purpose of making electronic payments from the possessor of the wallet to a merchant at a remote site on the Internet. For a transaction, the user selects the appropriate wallet by using the appropriate software or inserting a smart card into a card reader. Security of the information is provided by a public key file containing public keys to be used for encrypting the payment information into an authorization ticket which is sent by the wallet to the merchant, and then forwarded to the account servicer for decryption, the decryption key being in the form of a private key held only by the account servicer, and to which the merchant and other parties have no access. For example, the customer makes an order, and the merchant requests an authorization ticket in the form of payment or account information encrypted by a public key. The card or software is then validated with the use of a PIN number. The transaction proceeds as follows:

When the merchant receives the authorization ticket, the merchant then embeds or

associates it with whatever information the merchant needs to provide the account servicer. The authorization ticket is then forwarded to the account servicer, at which point the account servicer uses the private key associated with the selected public key in order to decrypt the file and verify the status of the account. If the transaction is approved, the account servicer then sends an approval message back to the merchant, together with decrypted information necessary for the merchant's records.

Chen, col. 6, lines 48-57 (emphasis added). However, independent claims 1, 43, 90 and 98 recite "providing at least a portion of said credentials to said user" and "receiving, at said server, a second request from said user, said second request including said portion of said assembled credentials provided to said user" (emphasis added). These features are nowhere disclosed or taught by Chen.

In fact, Chen merely discloses that the merchant embeds the authorization ticket with information to provide to the account servicer, and forwards the authorization ticket with the embedded information to the account servicer, at which point the account servicer verifies the status of the account with the merchant.

In the Office Action, dated February 17, 2005, the Examiner disagreed with the Applicants' argument that Chen does not teach the steps of "providing at least a portion of said credentials to said user; [and] receiving, at said server, a second request from said user, said second request including said portion of said assembled credentials provided to said user," as recited in independent claim 1 and similarly recited in independent claims 43, 90 and 98. Specifically, the Examiner argued:

Chen et al. disclose creating a wallet by gathering information including a message authentication code (MAC), which is then associated with a public key file (see col. 6, lines 12-18. Note. It is known in the art that a MAC includes both data and a secret key. This wallet, which includes a MAC, is provided to the user, which is the step of "providing at least a portion of said assembled credentials to said user" (see col. 6, lines 21-27). The user then uses the wallet to complete a transaction with a merchant, during this process the merchant receives "a second request from said user, said second request including said portion of said assembled credentials provided to said user" (see col. 6, lines 28-57).

Office Action, dated February 17, 2005, p. 2, para. 2.

Applicants respectfully submit that the passages cited by the Examiner fail to supply the elements missing from Linehan. Specifically, the Applicants respectfully submit that the step of creating a wallet does not correspond to the step of assembling credentials for the transaction at said server. According to Chen, the step of creating the wallet occurs prior to carrying out the transaction, and occurs independently of the specific transaction. However, in the claimed invention, the step of assembling credentials occurs after receiving a transaction request from a user, issuing a challenge to the user, receiving a response from the user based upon the challenge, and processing said response to verify an instrument or a user. *See, e.g.*, claims 1, 43, 90 and 98. Moreover, the step of assembling credentials is tied to the individual transaction, and the credentials are specific to the individual transaction. It is respectfully submitted that the act of creating the wallet, as described by Chen, is not equivalent to the step of “assembling credentials for the transaction at said server,” as asserted by the Examiner. Therefore, Chen fails to supply the elements missing from Linehan to arrive at the claimed invention.

Thus, Applicants respectfully submit that the combination of Linehan and Chen fails to teach or suggest all of the elements recited in the independent claims. With respect to claim 98, the disclosure of Atsmon also fails to provide the missing elements. Applicants therefore respectfully assert that the independent claims are patentably distinct from the combination of Linehan, Chen, and, for claim 98, Atsmon, and, therefore, are in condition for allowance.

Moreover, in combining Linehan with Chen (with respect to claims 1, 43 and 90), and combining Linehan with Chen and Atsmon (with respect to claim 98), it appears that the Examiner has merely located isolated disclosures that purport to illustrate disparate elements of the present invention. Applicants respectfully submit that the Examiner is engaging in *hindsight*

*reconstruction* to pick and choose between the isolated disclosures in the art to deprecate the claimed invention. Of course, it is well-established that *hindsight reconstruction* of an invention is impermissible. See *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

In considering obviousness, the critical inquiry is whether something in the art as a whole suggests the desirability, and thus the obviousness, of making a combination. See *In re Newell*, 891 F.2d 899, 901-902 (Fed. Cir. 1989). However, neither Linehan nor Chen (nor Atsmon, for that matter) suggests the desirability of any combination that would yield Applicants' claimed invention. For example, the Examiner states: "One of ordinary skill in the art would have been motivated [to modify Linehan with Chen et al. and Atsmon et al.] because it provides additional security by preventing unauthorized security by preventing unauthorized individuals from accessing the service." Office Action, dated February 17, 2005, p. 4, para. 5. The Examiner has merely extrapolated a motivation from one of the purposes of the references.

While the Examiner is correct that the cited references and the present invention all increase the security of transactions, Applicants respectfully submit that the Examiner has failed to provide any evidence of a desirability to combine Linehan, Chen, or Atsmon and explain why one having ordinary skill in the art would combine the disclosures to arrive at the claimed invention.

Because the Examiner has failed to establish a *prima facie* case of obviousness in combining Linehan with Chen with respect to claims 1, 43 and 90, and Linehan with Chen and Atsmon with respect to claim 98, the rejections under 35 U.S.C. § 103 are improper and should be withdrawn.

With respect to rejected claims 2-4, 44-46, 91-97 and 99-103, Applicants respectfully submit that these claims, which depend from independent claims 1, 43, 90 and 98, either directly

or indirectly, are also allowable for at least the reasons described above with respect to the independent claims, as well as in view of their own respective features.

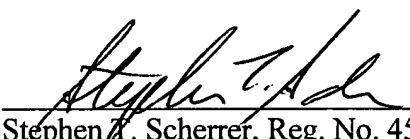
### CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicants urge the Examiner to telephone Applicants' attorney so that the same may be resolved and the application expedited to issue. Applicants respectfully request the Examiner to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

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MCDERMOTT WILL & EMERY LLP  
227 West Monroe Street  
Chicago, Illinois 60606-5096  
tel. no.: 312.372.2000  
fax. no.: 312.984.7700

  
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Stephen T. Scherrer, Reg. No. 45,080  
One of the Attorneys for Applicants